

#10
Rose

Attorney Docket No. FERN-P003

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BOARD OF
PATENT APPEALS AND INTERFERENCES**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Fernandez et al.

Examiner: Bahgi, H.

Application No. 09/095,390

Art Unit: 2711

Filed: 6/10/1998

For: DIGITAL TELEVISION WITH
SUBSCRIBER CONFERENCE
OVERLAY

Asst. Commissioner for Patents
Washington D.C. 20231



RECEIVED

MAY 16 2000

GROUP 2700

APPEAL BRIEF
IN SUPPORT OF APPELLANTS' APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Dear Sir:

The Appellants hereby submit, in triplicate, the following Brief pursuant to 37 CFR 1.192 in support of the appeal from a final decision by the Examiner, mailed November 9, 1999, in the above-captioned case. The Appellants respectfully request consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the above-captioned patent application.

05/15/2000 JDOBLE 00000047 09095390

01 FC:221 130.00 OP
02 FC:220 150.00 OP

TABLE OF CONTENTS

I.	REAL PARTY IN INTEREST	3
II.	RELATED APPEAL AND INTERFERENCES	3
III.	STATUS OF CLAIMS	3
IV.	STATUS OF AMENDMENTS	3
V.	SUMMARY OF INVENTION	4
VI.	ISSUES	4
VII.	GROUPING OF CLAIMS	4
VIII.	ARGUMENT	5
	A. OVERVIEW OF THE PRIOR ART USED IN THE REJECTION	5
	B. FIRST CLAIM GROUP	7
	C. THE EXAMINER FAILS TO ESTABLISH A PRIMA FACIE CASE OF OBVIOUSNESS	9
IX.	CONCLUSION	10
X.	APPENDIX A	12
XI.	APPENDIX B	16

I. REAL PARTY IN INTEREST

The real parties in interest are Dennis Fernandez and Irene Hu Fernandez, individuals, both having a principal place of business at 1047 El Camino Real, Suite 201, Menlo Park, CA 94025.

II. RELATED APPEAL AND INTERFERENCES

To the best of Appellants' knowledge, there are no appeals or interferences related to the present appeal which will directly affect, be directly affected by, or have a bearing on the Board's decision.

III. STATUS OF CLAIMS

Claims 1-10 are currently pending and stand rejected by the Examiner under the Final Office Action mailed on November 9, 1999.

Claims 1, 6, and 8 are independent.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (US Pat. 5,600,364) in view of Flohr et al. (US Pat. 5,534,914).

IV. STATUS OF AMENDMENTS

Claims 1-10 appended hereto in Appendix A reflect an amendment of December 16, 1998, while Appendix B contains claims 1-10, as they were originally standing before the December 16, 1998 amendment.

V. SUMMARY OF INVENTION

The invention resides in a digital television (DTV) system, apparatus, and method thereof, for enabling subscriber conference overlay during program delivery. In particular, the invention enables video conferencing to be conducted between DTV subscribers during delivery of a common program simultaneously to such DTV subscribers.

VI. ISSUES

The issue presented in this appeal is whether claims 1-10 are rendered unpatentable in view of Hendricks et al. and Flohr et al.

More specifically, the following issues are presented in this appeal:

- Whether Hendricks et al. teaches or renders obvious a system for sending messages between users.
- Whether it would have been obvious to combine the system of Hendricks et al. with that of Flohr et al. to provide video conferencing between DTV subscribers simultaneously with common program delivery to such DTV subscribers.

VII. GROUPING OF CLAIMS

For the purposes of this appeal, the claims are grouped as follows:

Group 1 : Claim 1-10

VIII. ARGUMENT

A. OVERVIEW OF PRIOR ART USED IN THE REJECTION

The Final Rejection, which is the subject of this appeal, is based on a 35 U.S.C. 103(a) rejection using the references of Hendricks et al. and Flohr et al, which are briefly discussed, as follow:

Hendricks et al.

Hendricks et al. describe a network controller for cable television delivery systems. In particular, Hendricks et al. describe (see: Column 13, lines 65-67, thru Column 14, lines 1-3) an introductory menu for displaying, using the set-top terminal, data sent to the subscriber from the cable headend (e.g., important announcements from the local cable franchise, advertisements from the cable provider, etc.) More particularly, such menu may inform the subscriber if the cable headend has sent a personal message to the subscriber's particular set-top terminal.

Hendricks et al. fail to describe or suggest, however, any messaging between subscribers. This is because Hendricks et al. never contemplated communication between subscriber set-top terminals, only between the cable headend and directly with a particular subscriber. Since Hendricks et al. fundamentally describe primarily a television delivery system, Hendricks et al. only contemplate a one-way messaging scheme wherein the cable headend may send a simple message downstream to a specific subscriber. This one-way scheme does not allow any subscriber to respond or otherwise

originate a message to be sent upstream to the cable headend, let alone to any other subscriber coupled to the cable system.

Hence, Hendricks et al. neither disclose nor suggest any way for a user to send messages to other users for conferencing-type communication therebetween.

Flohr et al.

Flohr et al. describe a videoconferencing system where, among other things, data messages *initiate and control transmission* of television signals over the network (see: column 8, lines 56-60.)

Flohr et al. fail to describe or suggest, however, videoconferencing between subscribers simultaneously with common program delivery to such subscribers. In fact, the "data messages" which Flohr et al. refer to are neither common program nor videoconferencing or other communication messages between subscribers, but are merely signals for initiating and controlling transmission of television signals. In particular, such data messages are used by Flohr et al. only for controlling the transmission of multiple television signals over different frequency channels.

As described by Flohr et al. in further detail (see: column 15, lines 1-33,) data message refers specifically to control signaling information including: source address, destination address, message type identification, message length, and message body (e.g., caller name and transmitting channel.) Clearly, such control signaling by Flohr et al. do

not constitute common program delivery nor videoconferencing messages provided simultaneously to subscribers.

Hence, Flohr et al. neither disclose nor suggest any way for video conferencing to be provided between subscribers simultaneously to common program delivery to such subscribers.

B. FIRST CLAIM GROUP

HENDRICKS ET AL. OR FLOHR ET AL., EITHER SINGLY OR IN COMBINATION, DO NOT DESCRIBE, OR SUGGEST THE ELEMENTS OF ENABLING VIDEO-CONFERENCE BETWEEN COUPLED DTV RECEIVERS SIMULTANEOUSLY DURING COMMON PROGRAM DELIVERY

Appellant's claim 1 provides in part (emphasis added):

... enabling a conference between the coupled DTV receivers during program delivery, the conference comprising a video conference session being conducted between such coupled DTV receivers, each DTV receiver comprising of a video camera and a display, such coupled DTV receivers being associated with a plurality of selected subscribers belonging to a logical group, the conference being enabled within the logical group simultaneously with the program delivery to the selected subscribers of the logical group, the display of each coupled DTV receiver displaying the delivered program and at least one selected subscriber in the conference, whereby collaboration is effectively enabled by video conferencing among the selected subscribers while a common program is delivered simultaneously to such selected subscribers.

Neither Hendricks et al. nor Flohr et al. describe or suggest the above-emphasized elements of Appellants' Claim 1. In particular, appellants respectfully submit that there is patentable scope in "enabling a conference between coupled DTV receivers during program delivery . . . the conference being enabled within logical group simultaneously with program delivery to selected subscribers of the logical group, the display of each coupled DTV receiver displaying the delivered program and at least one selected subscriber in the conference . . . collaboration effectively enabled by **video conferencing among selected subscribers while a common program is delivered simultaneously to selected subscribers.**"

Furthermore, for the present purpose of differentiating patentably against Hendricks et al. and Flohr et al. with regard to all the claims in this First Group, Appellants respectfully submit that such emphasized elements are substantially applicable to differentiate claims 2-5 which depend on claim 1, as well as claims 6-10.

In particular, to the extent that neither Hendricks et al. nor Flohr et al. describe or suggest the elements of video conferencing between selected subscribers (i.e., as specified in claims 6-7) or between conference participants (i.e., as specified in claims 8-10) simultaneously with program delivery, Appellants hereby respectfully submit that the combination of Hendricks et al. with Flohr et al. does not satisfy all the claimed elements of the present invention in this First Group of claims; and therefore, the rejection should be reversed.

C. THE EXAMINER FAILS TO ESTABLISH A PRIMA FACIE CASE OF OBVIOUSNESS

Appellant respectfully points out that according MPEP 706.02 (j), second paragraph, “to establish a prima facie case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations” (emphasis added).

Furthermore, in Northern Telecom Inc. v. Datapoint Corp., 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir.), cert. denied, 498 US 920, 111 S.Ct. 296, 112 L.Ed.2d 250 (1990), the Court of Appeals for the Federal Circuit stated that when the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.

To reiterate, in part, the Examiner’s rejection in the Final Office Action dated November 9, 1999 (emphasis added):

1. Regarding Hendricks et al., on page 6, lines 10-20, of the Office Action: “Hendricks clearly discloses personal message delivery to selected user’s set top box . . . Therefore, *Hendricks does provide a system where a user can send personal message to another user by providing communication between users of the system in the form of “messages”*. . . Replacing the simple user messaging system of Hendricks with the enhanced messaging system (video conferencing) of Flohr would have enabled users in the Hendricks system to communicate “visually” in addition to the text-type of communication in Hendricks . . .”

2. Regarding Flohr et al., on page 3, lines 14-18: “Considering the limitation of a *common program delivered simultaneously is taught by Flohr as the data messages* initiate and control the transmission of the television signals on the B-LAN such that a

number of television signals can be, and are transmitted simultaneously on the B-LAN with each television signal assigned to a separate frequency channel . . .”

Appellants respectfully submit that such arguments by the Examiner in support of obvious combination of the foregoing references are now overcome (i.e., Hendricks et al. do not describe or suggest messaging between users, and Flohr et al. do not describe or suggest common program delivery using data messages.)

Therefore, neither Hendricks et al. nor Flohr et al., singly or in combination, describe or suggest the method, system, or apparatus claimed presently by appellants. As such, Appellants submit that the Examiner fails to establish a prima facie case of obviousness.

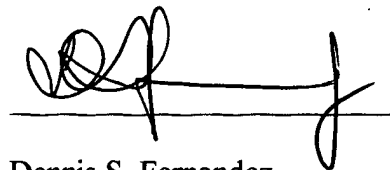
IX. CONCLUSION

For the foregoing reasons, Appellants submit that the applicable rejection under 35 USC 103(a) has been overcome, and the claims are in condition for allowance. If there are additional charges not accounted for herein, please charge them to Deposit Account No. 500482.

Respectfully Submitted,

FERNANDEZ & ASSOCIATES, LLP

Date: May 9, 2000



Dennis S. Fernandez
Reg. No. 34,160

Fernandez & Associates, LLP
P.O. Box D
Menlo Park, CA 94026-6204
(650) 325-4999

Certificate of Mailing By "U.S. Express Mail" Under 37 C.F.R. 1.10(c)

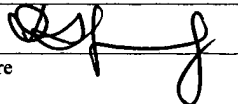
"EXPRESS MAIL" Mailing Label Number: EL547553592 VS

Date of Deposit: 5/9/00

I hereby certify that this paper and/or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Assistant Commissioner For Patents, Washington D.C. 20231

Name: DENNIS FERNANDEZ

Signature



Signature Date

5/9/00

X. APPENDIX A

Claims Presented For Appeal
(as amended by 12/16/1998 amendment)

1. In a digital television system comprising a plurality of receivers coupled to a program source, a method for providing subscriber conferencing with program delivery comprising the steps of:

\coupling a program source to a plurality of digital television (DTV) receivers;
delivering a program from the program source to the DTV receivers coupled thereto; and

enabling a conference between the coupled DTV receivers during program delivery, the conference comprising a video conference session being conducted between such coupled DTV receivers, each DTV receiver comprising a video camera and a display, such coupled DTV receivers being associated with a plurality of selected subscribers belonging to a logical group, the conference being enabled within the logical group simultaneously with the program delivery to the selected subscribers of the logical group, the display of each coupled DTV receiver displaying the delivered program and at least one selected subscriber in the conference, whereby collaboration is effectively enabled by video conferencing among the selected subscribers while a common program is delivered simultaneously to such selected subscribers.

2. The method of Claim 1 further comprising the step of:
sending a billing message to one or more of the coupled DTV receivers according to program viewing or conferencing activity, the billing message representing a charge for simultaneous program delivery and video conferencing service.
3. The method of Claim 1 further comprising the step of:
providing to one or more coupled DTV receiver a personalized commercial message, the personalized commercial message being provided to the selected subscribers belonging to the logical group during the video conferencing session.
4. The method of Claim 1 wherein:
each coupled DTV receiver comprises a controller for coordinating simultaneous program delivery and video conferencing among the selected subscribers.
5. The method of Claim 1 further comprising the step of:
adding or removing a DTV receiver coupled to the program source during program delivery, thereby dynamically modifying an active set of the selected subscribers belonging to the logical group for simultaneous video conferencing and common program delivery.
6. A digital television system comprising:
a program source; and

a plurality of digital television (DTV) receivers coupled to the program source;

wherein a program is deliverable from the program source to the DTV receivers, and a conference is enabled between the coupled DTV receivers, the conference comprising a video conference session being conducted between such coupled DTV receivers, each DTV receiver comprising a video camera and a display, such coupled DTV receivers being associated with a plurality of selected subscribers belonging to a logical group, the conference being enabled within the logical group simultaneously with the program delivery to the selected subscribers of the logical group, the display of each coupled DTV receiver displaying the delivered program and at least one selected subscriber in the conference, whereby collaboration is effectively enabled by video conferencing among the selected subscribers while a common program is delivered simultaneously to such selected subscribers.

7. The system of Claim 6 wherein:

each DTV receiver comprises a processor for coordinating simultaneous program delivery and video conferencing among the selected subscribers.

8. Digital television apparatus comprising:

a display, a camera, and an interface;

wherein the interface couples to a program source for presentation of a program by the display, the interface receiving a conference signal from a conference participant for presentation of a video conference by the display, and the camera generating a video signal for transmission to the conference participant, the video conference comprising a

session being conducted with the conference participant during the presentation of the program, the display integrating through a frame buffer the program and the received conference signal according to an active set, thereby graphically combining video conferencing with the conference participant during the program delivery.

9. The apparatus of Claim 8 further comprising:

a controller for controlling simultaneous program delivery and video conferencing within the active set, the controller being able to modify the active set dynamically by adding or removing one or more conference participants.

10. The apparatus of Claim 8 where in:

the interface receives a billing message representing a charge for simultaneous program delivery and video conferencing service or a commercial message associated with the active set.

XI. APPENDIX B

Claims Presented For Appeal

(prior to change from amendment of 12/16/1998)

1. In a digital television system comprising a plurality of receivers coupled to a program source, a method for providing subscriber conferencing with program delivery comprising the steps of:

coupling a program source to a plurality of digital television (DTV) receivers;

delivering a program from the program source to the DTV receivers coupled thereto; and

enabling a conference between the coupled DTV receivers during program delivery.

2. The method of Claim 1 further comprising the step of:

sending a billing message to one or more of the coupled DTV receivers according to program viewing or conferencing activity.

3. The method of Claim 1 further comprising the step of:

providing to one or more coupled DTV receiver a personalized commercial message.

4. The method of Claim 1 wherein:

each coupled DTV receiver comprises a video camera, such that the conference comprises a multi-way video conference between coupled DTV receivers.

5. The method of Claim 1 further comprising the step of:

adding or removing a DTV receiver coupled to the program source during program delivery.

6. A digital television system comprising:

a program source; and

a plurality of digital television (DTV) receivers coupled to the program source;

wherein a program is deliverable from the program source to the DTV receivers, and a conference is enabled between the coupled DTV receivers.

7. The system of Claim 6 wherein:

each DTV receiver comprises a video camera, such that the conference comprises video conference between coupled DTV receivers.

8. Digital television apparatus comprising:

A display, a camera, and an interface;

Wherein the interface couples to a program source for presentation of a program by the display, the interface receiving a conference signal from a conference participant for presentation of a video conference by the display, and the camera generating a video signal for transmission to the conference participant.